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In re application: Hays, Jr., et al.
Serial No.: 10/079,692
Filed: 02/20/2002
Group Art Unit: 3683
Examiner: Kramer, Devon C.
For: NON-METALLIC BRAKE PLATE

REQUEST FOR RECONSIDERATION

Mail Stop AF
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This paper is responsive to the Office Action mailed on February 19, 2004.

Applicant respectfully traverses the rejections restated in the Final Office Action. Applicant has already pointed out that the *Grimme* reference utilizes a carrier plate 10 that requires encasing the friction material block 20 as clearly taught by that reference. To interpret the carrier plate 10 as proposed by the Examiner ignores the express teachings of the reference. Applicant respectfully submits that claims 1 and 18 are not anticipated.

Applicant has already pointed out that claim 3 cannot be considered obvious because there is no *prima facie* case of obviousness. There is no motivation for combining the *Grimme* reference with the *Stahl* reference. Adding an adhesive to the

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Grimme arrangement would be redundant, at best and, therefore provides no benefit. Without any benefit there is no *prima facie* case of obviousness.

Applicant has also already pointed out that the combination of the *Grimme* reference and the *Kwolek* reference cannot be made. There is no benefit to adding rivets to the *Grimme* arrangement and, therefore, no motivation for making the combination. Claim 4 cannot be considered obvious.

Similarly, there is no motivation for making the combination of the *Grimme* reference with the *Strusser* reference. Because the *Grimme* reference teaches a carrier plate 10 that encases the friction material block 20, there is no motivation for adding the portions of the *Strusser* reference proposed by the Examiner. There would be no benefit to doing that because the *Grimme* reference already takes care of holding the carrier plate around the friction block 20. Without any motivation for making the combination, there is no *prima facie* case of obviousness and claims 5 and 20-22 must be allowed.

Claims 6, 8 and 23-24 cannot be considered obvious over the proposed combination of the *Grimme* and *Kearsey* references. Neither reference provides any indication or suggestion for combining their teachings to arrive at the result of Applicant's claimed invention. Using Applicant's disclosure as a road map for hindsight reasoning is not permissible when attempting to establish a *prima facie* case of obviousness. Some motivation must be provided by the art for making the proposed combination. Because the friction block 20 of the *Grimme* reference is encased by the carrier plate 10 on at least three sides and a portion of a fourth side, there is nothing within that reference that would lead a skilled artisan to believe that a wet disc brake plate as claimed in claim 23, for example, would be an alternative environment for the

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teachings of the *Grimme* reference. Without any motivation for making a combination or modification and without any suggestion within the art of doing so, there is no *prima facie* case of obviousness.

Adding the teachings of *Ohya* to the improper combination of the *Grimme* and *Kearsey* references does not remedy the defect in the base combination and, therefore, claims 7 and 26 cannot be considered obvious, either.

There is no motivation for combining the *Grimme* reference and the *Ohya* reference when attempting to reject claims 9 and 19. When one considers the teachings of the two references and that they take opposite approaches, there is no suggestion within them for making the combination proposed by the Examiner. Hindsight reasoning based on Applicant's disclosure is not a proper source of suggestion or motivation. The *Grimme* reference teaches forming the friction block 20 and then molding the carrier plate 10 around it. The *Ohya* reference, on the other hand, teaches forming a substrate first and then molding a friction material in place. As these two references take opposite approaches, there is no suggestion or motivation for taking a piece of the *Ohya* reference and substituting it in for a piece in the *Grimme* reference. The combination cannot be made in claims 9 and 19 cannot be considered obvious.

The rejection of claim 25 based upon a combination of the *Grimme*, *Strasser* and *Lam* references fails for the same reason as the rejection of claims 5 and 20-22. The *Grimme* and *Strasser* references cannot be combined.

At a minimum, Applicant urges the Examiner to withdraw the rejections under 35 U.S.C. §103. There is no *prima facie* case and Applicant is confident that none of those rejections will survive an appeals conference because there is no legal motivation for

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making the proposed combinations. Applicant respectfully asks the Examiner to at least withdraw those rejections. Applicant also believes that the *Grimme* reference does not anticipate claim I as mentioned above, but if the Examiner would at a minimum withdraw the 103 rejections, that would simplify issues for appeal.

Applicant believes that this case is in condition for allowance.

Respectfully submitted,

CARLSON, GASKEY & OLDS

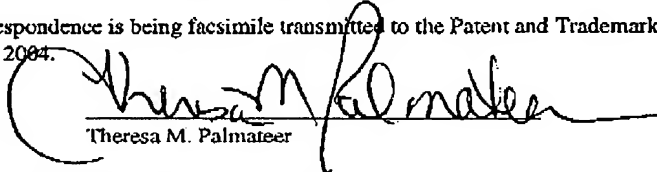
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Dated: April 19, 2004

CERTIFICATE OF FACSIMILE

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax No. (703) 872-9306) on April 19, 2004.


Theresa M. Palmateer

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